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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.												
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23368 7590 10/25/2007 DINSMORE & SHOHL LLP ONE DAYTON CENTRE, ONE SOUTH MAIN STREET SUITE 1300 DAYTON, OH 45402-2023			<table border="1"><thead><tr><th colspan="2">EXAMINER</th></tr></thead><tbody><tr><td colspan="2">BATTULA, PRADEEP CHOUDARY</td></tr></tbody></table> <table border="1"><thead><tr><th>ART UNIT</th><th>PAPER NUMBER</th></tr></thead><tbody><tr><td>3722</td><td></td></tr></tbody></table> <table border="1"><thead><tr><th>MAIL DATE</th><th>DELIVERY MODE</th></tr></thead><tbody><tr><td>10/25/2007</td><td>PAPER</td></tr></tbody></table>		EXAMINER		BATTULA, PRADEEP CHOUDARY		ART UNIT	PAPER NUMBER	3722		MAIL DATE	DELIVERY MODE	10/25/2007	PAPER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/693,469	Applicant(s) REFFETT, TED J.	
	Examiner Pradeep C. Battula	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-28, 30 and 33-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-28, 30 and 33-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This application is in response to the reply filed on July 19, 2007

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 37 – 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Buske.

In regards to Claim 37, Buske discloses a combination packing list and shipping label form (examiner considers one form to constitute multiple labels in assembly) configured to be affixed to an object (Figure 7), said form comprising: a packing list comprising: a packing list first ply 20 comprising a front and a back opposite said front (Figure 9, Item 20); a first line of weakness 21 formed in said front of said packing list first ply such that a first printable region is bounded by said packing list first line of weakness (Column 2, Lines 51 – 54; Figure 1, Item 21), said first printable region configured to accept printed indicia thereon (Column 2, Lines 38 – 50; Figure 1); a patterned release layer facing said back of said packing list first ply (Column 2, Lines 33 – 37); an adhesive layer 23 facing each of said back of said packing list first ply and said patterned release layer (Column 2, Lines 33 – 40; Figure 9, Item 23); a packing list second ply 22 comprising a front and a back opposite said front (Figure 9, Item 22), said packing list second ply facing said adhesive layer (Figure 9, Items 22, 23) such that at

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least a portion of said front of said second ply is bonded to at least a portion of said back of said first ply to define a multi-ply label (Column 2, Lines 38 – 40); a packing list second line of weakness (created at 29) formed in said back of said packing list second ply such that a second printable region 25 is bounded by said packing list second line of weakness (Column 2, Lines 41 – 44; Figure 9, Items 25, 29); and a shipping label contiguous with said packing list, said shipping label comprising: a shipping label first ply comprising 20 a front and a back opposite said front (Figure 9, Item 20), said front configured to receive variable indicia printed thereon (Column 2, Lines 51 – 54); a shipping label line of weakness 21 formed in said front of said shipping label first ply (Column 2, Lines 51 – 54; Figure 1, Item 21); an adhesive layer 23 facing said back of said shipping label first ply (Column 2, Lines 33 – 40; Figure 9, Item 23); a release layer facing at least a portion of said adhesive layer (Column 2, Lines 35 – 37; Figure 9, Item 22, 23); and a shipping label second ply 22 comprising a front and a back opposite said front (Figure 9, item 22) such that said front of said shipping label second ply faces said release layer (Column 2, Lines 35 – 37).

With respect to the line of weakness formed in said front of said shipping label first ply to aid in removing said shipping label from said form; it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

In regards to Claim 38, as applied to Claim 37, Buske further discloses wherein said packing list second line of weakness 24 (Column 2, Lines 48 – 49) is disposed

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substantially coextensive with said packing list first line of weakness (Figure 9, Items 21, 24; repeated).

In regards to Claim 39, as applied to Claim 37, Buske further discloses a separable region (boundary lines 21; Figure 2) disposed about said packing list second line of weakness (at contour 24); and a border region disposed about said shipping label line of weakness (boundary line 21 of next label).

In regards to Claim 40, as applied to Claim 39, Buske further discloses wherein said separable region comprises said packing list second printable region and an affixing region adjacent said packing list second printable region (Column 2, Lines 56 – 58; Figure 7; Figure 9, Items 20, 22; Figure 10, Items 20, 22).

In regards to Claim 41, as applied to Claim 37, Buske further discloses whereby said form is configured such that said fronts of said first plies of said shipping label and said packing list are substantially coplanar with one another (Column 2, Lines 38 – 50; Figure 9, all labels co-planar).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 42, 2 – 16, and 18 – 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buske in view of Konkol et al. (Konkol; U.S. 5,735,549).

In regards to Claim 42, Buske discloses a form comprising a first ply 20 (Figure 9, Item 20) and a second ply 22 (Figure 9, Item 22), each of said plies with an inner surface and an outer surface (Figure 9, Items 20 and 22 are separate plies and clearly have inner and outer surfaces); and a plurality of labels defined in said form, at least one of said plurality of labels separable from said form along a corresponding line of weakness 21 and created by cutter 30 (Column 2, Lines 45 – 54), said plurality of labels comprising: a first label comprising a first printable region (Figure 1, Item 20) and on said outer surface of said first ply (Column 2, Lines 42 – 43), a second printable region 25 on said outer surface of said second ply (Column 2, Line 41 – 43; Figure 9, Item 25) that faces an opposite direction of said first printable region (Figure 1; Figure 2) and is substantially coextensive therewith (Figure 1; Figure 2), an affixing region (where adhesive 23 exists) at least partially disposed about said second printable region and configured to remain with said first label upon removal thereof from said form (Column 2, Lines 32 – 50), a first label adhesive layer 23 coupled to said inner surface of said second ply (Column 2, Lines 33 – 40; through the release), said first label release layer and said first label adhesive layer cooperative with one another and said corresponding line of weakness such that upon removal of said first label from said form, at least a portion of said first label adhesive layer that is coextensive with said affixing region becomes exposed (Column 2, Lines 38 – 54) to allow said first label to be adhesively affixed to an object (Column 2, Lines 52 – 58); and a second label comprising a third printable region on a different portion of said outer surface of said first ply (Column 2, Lines 38 – 50; the following label can be considered another printable region) from said

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first label, a second label adhesive layer coupled to said inner surface of said first ply (Column 2, Lines 33 – 40; Figure 10, Item 23), a second label release layer disposed between at least a portion of said inner surface of said second ply and said second label adhesive layer (Column 2, Lines 33 – 37), said second label release layer and said second label adhesive layer cooperative with one another such that upon removal of said second label, said second label adhesive layer becomes exposed to allow said second label to be adhesively affixed to an object (Column 2, Lines 52 – 58), wherein said form is configured such that at least said printable regions on each said first and second labels of said label set corresponding to said first ply can accept printed indicia thereon from a single pass through an automated simplex printing device (Column 2, Lines 38 – 43).

Buske does not disclose a first label release layer disposed between at least a portion of said inner surface of said first ply and said first label adhesive layer.

Konkol discloses a dual ply label 10 where spot coating is done in order to allow for a particular section of the two mated plies to be permanently adhered (Column 4, Lines 35 – 36, Lines 54 – 61). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the teachings of Konkol in order to allow for certain areas to adhere or release from the plies of Buske.

In regards to Claim 2, as applied to Claim 42, Buske modified by Konkol further discloses a separable region is at least partially bounded along a cut line 29 that extends depth wise through at least said second ply (Column 2, Lines 43 – 44; Buske).

Buske does not disclose the cut is lengthwise substantially from one edge of said second ply to another. However, the fact that the cut is longer lengthwise is not stated as critical by the applicant and furthermore does not create an unexpected result. It only makes the second ply printable region of greater size lengthwise. It would have been an obvious matter of design choice to create a longer lengthwise cut because such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

In regards to Claim 3, as applied to Claim 42, Buske does not disclose wherein said second ply printable region is permanently adhered to said first ply first printable region.

Konkol discloses a dual ply label 10 where spot coating is done in order to allow for a particular section of the two mated plies to be permanently adhered (Column 4, Lines 35 – 36, Lines 54 – 61). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the teachings of Konkol in order to prevent the coupon of Buske from being removed from the first ply.

In regards to Claim 4, as applied to Claim 42, Buske modified by Konkol further discloses wherein said form is a cut sheet (Column 2, Lines 38 – 50; Buske).

In regards to Claim 5, as applied to Claim 42, In Buske modified by Konkol it is seen that the ply's are rolled and separated in the prior art but, an omission of an element and its function is obvious if the function of the element is not desired. *In re*

Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975). In Applicant's case, two rolls are not desired and the user separates the labels from the carrier sheets/plies. Therefore it would have been obvious to remove roll process 33 of Buske because it is held that removing an element is obvious to one with ordinary skill in the art.

In regards to Claim 6, as applied to Claim 42, Buske modified by Konkol further discloses wherein said first ply second printable region is disposed laterally adjacent said first ply first printable region on said form (The examiner considers two first ply labels to comprise the adhesive form).

In regards to Claim 7, as applied to Claim 42, Buske modified by Konkol further discloses wherein said first ply second printable region is disposed longitudinally adjacent said first ply first printable region on said form (Examiner considers that more than one cut label can be used in the adhesive form).

In regards to Claims 8 and 9, as applied to Claim 42, Buske modified by Konkol further discloses a label with indicia (Figure 1; Buske). Buske modified by Konkol discloses the claimed invention except for the specific arrangement and/or content of indicia (shipping indicia) set forth in the claim(s). It has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of information does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

The examiner asserts that the label comprising instructive indicia is the same structure claimed by applicant and the sole difference is in the content of the printed material. Thus, there is no novel and unobvious functional relationship between the printed matter (shipping indicia) and the substrate (ply) which is required for patentability.

Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.

In regards to Claim 10, as applied to Claim 8, Buske modified by Konkol further discloses wherein said adhesive layer is disposed across a substantial entirety of said front of said second ply that corresponds to said indicia (Column 2, Lines 33 – 40; Figure 9, Item 23; Buske).

In regards to Claim 11, as applied to Claim 10, Buske modified by Konkol further discloses wherein said adhesive layer is disposed across a substantial entirety of said back of said first ply corresponding to said second label (Column 2, Lines 33 – 40; Figure 9, Item 23; Buske).

In regards to Claim 12, as applied to Claim 10, Buske does not disclose wherein said release layer disposed between said first and second plies of said first label is patterned such that it only occupies the portion outside said corresponding line of weakness defined in said first printable region.

Konkol discloses a dual ply label 10 where spot coating is done in order to allow for a particular section of the two mated plies to be permanently adhered (Column 4,

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Lines 35 – 36, Lines 54 – 61). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the teachings of Konkol in order to prevent the coupon of Buske from being removed from the first ply.

In regards to Claim 13, as applied to Claim 42, Buske does not disclose wherein at least one of said lines of weakness comprises a full die cut.

Konkol discloses a dual ply label 10 where in panels to be removed are die cut (Column 4, Lines 35 – 36; Column 5, Lines 1 – 2). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use die cuts in place of perforations it is a mere substituting of equivalents known for the same purpose of separating components (Column 2, Lines 59 – 61; Buske).

In regards to Claim 14, as applied to Claim 42, Buske modified by Konkol further discloses wherein at least one of said lines of weakness comprises a perforated die cut (Column 2, Lines 51 – 54; Buske).

In regards to Claim 15, as applied to Claim 42, Buske modified by Konkol further discloses wherein at least one of said lines of weakness is substantially rectangular in shape (Figure 1 Item 21; Buske).

In regards to Claim 16, as applied to Claim 15, Buske discloses wherein said line of weakness 21 corresponding to said first label in said second ply is a perforated die cut (Column 2, Lines 51 – 54) and cuts made at 29 and 30 (Column 2, Lines 43 – 45).

Buske does not disclose wherein said lines of weakness corresponding to said first and second labels in said first ply are full die cuts.

Konkol discloses a dual ply label 10 where in panels to be removed are full die cut (Column 4, Lines 35 – 36; Column 5, Lines 1 – 2). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to use full die cuts in order to more smoothly remove labels as shown in Konkol (Figure 5; Konkol).

In regards to Claim 18, as applied to Claim 42, Buske modified by Konkol further discloses the form comprising pre-printed indicia on a portion of said outer surface of said second ply (Column 2, Lines 38 – 45; Figure 2; pre-printed considered to be prior to cutting and rolling; Buske).

In regards to Claims 19 – 22, as applied to Claim 42 (20 - 22) and Claim 18 (19), Buske discloses the claimed invention except for the specific arrangement and/or content of indicia (instructional, product, aesthetic or linking indicia) set forth in the claim(s). It has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of information does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

The examiner asserts that the form comprising indicia is the same structure claimed by applicant and the sole difference is in the content of the printed material. Thus, there is no novel and unobvious functional relationship between the printed

matter (instructional, product, or linking indicia) and the substrate (first and second plies) which is required for patentability.

Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.

3. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buske in view of Konkol and Franklin (U.S. 5,255,456).

In regards to Claim 17, as applied to Claim 16, Buske modified by Konkol does not disclose wherein at least one corner defined in said perforated die cut comprises a full die cut to facilitate ease of grasping.

Franklin discloses of a substantially rectangular perforation 6 in a double layer card which has a corner 9 that is die cut in order to allow easy removal without tearing. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention to have a full die cut corner in a perforated line of weakness in order to allow easy removal without tearing (Column 3, Lines 39 – 50; Franklin).

4. Claims 23 – 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buske in view of Konkol and Horton-Steidle et al. (Horton; U.S. 6,167,679).

In regards to Claims 23 and 24, as applied to Claim 42, Buske modified by Konkol does not disclose an overlap region defined by stacked relationship between a portion of said first ply and a portion of said second ply such that said first and second labels are not coplanar with one another.

Horton discloses two bodies 20, 30 with both having two plies (22, 26, 32) of the same material where both bodies have their respective plies connected by adhesive 24, 34 (Column 2, Lines 17 – 21; 35 – 39; Figure 1B, Items 20, 22, 24, 26, 30, 32, 34); wherein the bodies are in stacked relationship where the bodies are not co planar and connected by a adhesive line 12 (Column 2, Lines 12 – 13). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to stack the different labels of Buske because it has been held that rearranging parts of an invention involves only routine skill in the art.

In regards to Claim 25, as applied to Claim 23, Buske modified by Konkol and Horton further disclose wherein portions of said second ply and said release layer that both correspond to one of said labels are removed prior to construction of said form such that a cutout defined by said removed portion is substantially coextensive with a corresponding portion of said other label (Column 2, Lines 29 – 37; Figure 10).

With respect to wherein portions of said second ply and said release layer that both correspond to one of said labels are removed prior to construction of said form; even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Furthermore, Applicant is merely removing all items except for the first ply outside of the label area because the liner, adhesive, and second ply in this area do not effect the use of either label. Omission of an element and its function is obvious if the function of the element is not desired. *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975).

In regards to Claims 26 and 27, as applied to Claim 42, Buske does not disclose an overlap region defined by a stacked relationship between a portion of said first ply and a portion of said second ply such that said first and second labels are substantially coplanar with one another.

Horton discloses two bodies 20, 30 with both having two plies (22, 26, 32) of the same material where both bodies have their respective plies connected by adhesive 24, 34 (Column 2, Lines 17 – 21; 35 – 39; Figure 1B, Items 20, 22, 24, 26, 30, 32, 34); wherein the bodies are in stacked relationship where the bodies are not co planar and connected by a adhesive line 12 (Column 2, Lines 12 – 13). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to stack the different labels of Buske because it has been held that rearranging parts of an invention involves only routine skill in the art.

Furthermore, Buske modified by Horton discloses the claimed invention except for a removal of certain items to make the labels substantially coplanar. Applicant is merely removing all items except for the first ply outside of the label area because the liner, adhesive, and second ply in this area do not effect the use of either label. Omission of an element and its function is obvious if the function of the element is not

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desired. *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975). Lastly, the modification discloses abutting plies and second plies where the abutting first plies are laterally offset relative to said abutting second plies.

In regards to Claim 28, as applied to Claim 42, Buske does not disclose wherein said first label comprises a first material and said second label comprises a second material, said second material being different from said first material, said form further comprising an overlap region wherein a portion of said first material adhesively overlaps a portion of said second material, bonding said first material to said second material and forming a seam therebetween.

Horton discloses two bodies 20, 30 with both having two plies (22, 26, 32) of the different material where both bodies have their respective plies connected by adhesive 24, 34 (Column 2, Lines 17 – 21; 35 – 39; Figure 1B, Items 20, 22, 24, 26, 30, 32, 34); wherein the bodies are in stacked relationship where the bodies are not co planar and connected by a adhesive line 12 (Column 2, Lines 12 – 13) forming a seam therebetween. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to stack the different labels of Buske because it has been held that rearranging parts of an invention involves only routine skill in the art.

5. Claims 43, 30, 33, 35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buske.

In regards to Claim 43, Buske discloses a multi-label form configured such that each label can accept variable simplex printing on at least one surface thereof (Column

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2, Lines 38 – 43) and be separately affixed to an object (Column 2, Lines 55 – 58), said form comprising: a first ply 20 (Figure 9, Item 20) and a second ply 22 (Figure 9, Item 22), a release layer and an adhesive layer 23 arranged such that said release and adhesive layers are disposed between said first and second plies to define a layered multi-ply construction (Column 2, Lines 33 – 40); a first label within said multi-ply construction (Figure 1, Item 20) and defined by lines of weakness 21 that form respective borders about at least a portion of a first printable region on said first ply and a second printable region on said second ply (Column 2, Lines 45 - 54), said form configured such that the portions of said adhesive and release layers that correspond to said first label are cooperative with one another (Column 2, Lines 33 – 43) such that upon removal of said first label from said form, a portion of said adhesive layer that corresponds to said first label and that at least partially surrounds said first printable region becomes exposed and stays with said second ply (Column 2, Lines 45 – 47; Figure 2) such that said first label can be adhesively affixed to the object with said first printable region facing toward the object (Column 2, Lines 55 – 58; Figures 7 – 8). Buske further discloses a second label defining a third printable region and disposed adjacent (and co-planar; Figure 9) said first label on said first ply (Column 2, Lines 45 – 50; Figure 9).

Buske does not disclose and a second label defining a third printable region thereon and constructed differently from and disposed adjacent said first label on said first ply, said second label formed within said multi-ply construction such that portions of said adhesive and release layers that correspond to said second label are cooperative

with one another such that upon removal of said second label from said form, said adhesive layer that corresponds to said second label becomes exposed and stays with said first ply such that said second label can be adhesively affixed to the object.

Buske discloses the claimed invention except for the label being of a different construction. It would have been obvious to one having ordinary skill in the art at the time the invention was made to remove the cut at station 29, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions (first ply sticking to a package) as before involves only routine skill in the art. *In re Larson*, 340 F.2d 965, 144 USPQ 347 (CCPA 1965).

In regards to Claim 30, as applied to Claim 43, Buske further discloses wherein at least a portion said first release layer is patterned (Column 2, Lines 35 – 37; constant pattern).

In regards to Claims 35 and 36, as applied to Claim 43, please review the rejection of Claims 8 and 9.

6. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buske in view of Horton.

In regards to Claim 34, as applied to Claim 43, Buske does not disclose an overlap region between said first label and said second label such that a portion of said form that corresponds to one of said labels adhesively overlaps a portion that corresponds to the other of said labels.

Horton discloses two bodies 20, 30 with both having two plies (22, 26, 32) of the same material where both bodies have their respective plies connected by adhesive 24,

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34 (Column 2, Lines 17 – 21; 35 – 39; Figure 1B, Items 20, 22, 24, 26, 30, 32, 34); wherein the bodies are in stacked relationship where the bodies are not co planar and connected by a adhesive line 12 (Column 2, Lines 12 – 13). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to stack the different labels of Buske because it has been held that rearranging parts of an invention involves only routine skill in the art.

Response to Arguments

Applicant's arguments filed July 19, 2007 have been fully considered but they are not persuasive. Buske does not teach explicitly of a packing list and shipping label, however, Buske does teach of a structure that is more than capable of performing that function and the only difference is in the printed matter.

Applicant disagrees with the examiner's conclusion that the printed matter required by the claims of the present application is not functionally related to the substrate. For reference please refer to *In re Miller*, 164 USPQ 46. In *Miller*, the claims were directed toward a measuring cup or receptacle for measuring partial recipes. Measuring indicia on the receptacle indicated a quantity different from the actual quantity measured. The indicia on the substrate was required to be located in a particular position to convey meaningful information in regard to the substrate. In other words, in order to accurately measure a substance to be used in a recipe, the indicia on the receptacle is required to be placed at specific measured locations. In this case, the printed elements of the invention acted in combination with the structure on which they

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were printed (the "substrate") to perform a function that was neither anticipated nor made obvious by the prior art.

In the present invention, the claimed label visually indicates the location of indicia and its ability to exist in several different areas. In contrast to *Miller*, the indicia placed on the substrate does not act in combination with the structure on which it is printed. Only the existence of indicia is shown and no particular arrangement making it more useful. Furthermore the reference of Buske further shows indicates that the opposite surface needs to be accessed. Therefore, the indicia on the labels merely comprise printed matter which is supported by a substrate where the printed matter does not convey any meaningful information in regard to the substrate and does not require any particular substrate to effectively convey the information. Thus, there is no meaningful functional relationship between the indicia and the substrate.

The examiner asserts that the combination protection label and coupon comprising two labels being adhered to one another is the same structure as applicant claims. Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.

Applicant's arguments with respect to Claims 42 and 2 –28; 43, 30, and 33 – 36 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pradeep C. Battula whose telephone number is 571-272-2142. The examiner can normally be reached on Mon. - Thurs. & alternating Fri. 7:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PCB
Patent Examiner
October 15, 2007

Monica S. Carter
MONICA CARTER
SUPERVISORY PATENT EXAMINER